

Serial Number: 09/733,476

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Title: I/C PACKAGE/ THERMAL-SOLUTION RETENTION MECHANISM WITH SPRING EFFECT

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S/N 09/733,476

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carlos A. Gonzalez et al.

Examiner: Tuan T Dinh

Serial No.: 09/733,476

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Docket: 884.355US1

Title: I/C PACKAGE/ THERMAL-SOLUTION RETENTION MECHANISM WITH
SPRING EFFECT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

In the Restriction Requirement mailed on May 21, 2002, election is required between four alleged "patentably distinct species" of the claimed invention. Applicant traverses the requirement and provisionally elects Embodiment IV (Figure 8). Applicant identifies the following claims as readable on the provisionally elected Embodiment IV: claims 1-25.

Traversal

The restriction requirement is traversed on the basis that it fails to meet the two criteria for a proper requirement for restriction between patentably distinct inventions. M.P.E.P. § 803 states that the two criteria for restriction between patentably distinct inventions are:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the examiner if restriction is required.

The Inventions Must Be Independent Or Distinct As Claimed. The restriction required is between four alleged "patentably distinct species" of the claimed invention. It is respectfully submitted that the four embodiments identified by the Restriction Requirement do not represent distinct "species" of the invention. In the M.P.E.P., it states:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. **This is frequently**

expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristic of such species. MPEP § 806.04(f). (Emphasis added).

The Restriction Requirement has not identified limitations that are found in the different species that are mutually exclusive.

In addition, Applicant also submits that claim 1 is generic to the retention mechanism disclosed in the specification. Claim 1 recites a retention mechanism for mounting an integrated circuit package to a circuit board. The retention mechanism has three components: a pressure plate, a backing plate, and means for applying forces to the plates. Claim 1 covers all versions of the figures presented in the application. None of the limitations of claim 1 require any of the specific species elaborated in the Restriction Requirement. Claim 1 is generic to all of the species of the Restriction Requirement. As such, Applicant believes that it has provided in the originally filed application a generic claim.

There Must Be A Serious Burden On The Examiner If Restriction Is Required. The restriction requirement has not established a *prima facie* case that there is a serious burden on the examiner. The M.P.E.P. states, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. § 803. Then M.P.E.P § 803 further states, "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." And, finally M.P.E.P. § 808.02 concludes, "Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, **no reasons exist for dividing among related inventions.**" (Emphasis added).

Applicant believes that the embodiments described in this application should be searched together. Applicant respectfully submits that a search of any one of the four groups of figures would encompass the subject matter of all the groups of figures. In other words, a search of any one of the four groups of figures would include a retention mechanism having a pressure plate, a backing plate, and means for applying forces to the plates. Thus, a search of all embodiments

could be made and the entire application could be examined without serious burden on the Examiner. Thus, Applicant respectfully requests withdrawal of the Restriction Requirement.

Provisional Election

Applicant believes that claim 1 is generic, that the four embodiments identified by the examiner do not represent distinct "species" of the invention, and that the entire application can be examined without serious burden on the examiner. However, Applicant provisionally elects, with traverse, the claims directed to the species of Embodiment IV. Applicant identifies claims 1-25 as being readable on the provisionally elected Embodiment IV for the reason stated below.

Figure 8 effectively describes the components of all three independent claims, 1, 11, and 23. Figure 8 shows and all three independent claims recite a pressure plate, a backing plate, and means for applying forces to effect continuous electrical continuity between the integrated circuit package and the circuit board. All other claims are dependent on these three independent claims, which as just shown are effectively disclosed by Figure 8. Therefore, Embodiment IV reads on all of the pending claims.

Examiner Interview

Applicant acknowledges the telephone interview held on May 7, 2002, between Examiner Dinh and Applicant's attorney, Ann McCrackin, during which an election of species requirement for claims 1-25 was discussed. No election of species was made. The Examiner indicated that he would send a written election of species requirement as the next paper.

Conclusion

Reconsideration and withdrawal of this restriction requirement is appropriate and respectfully requested. The Examiner is invited to contact Applicant's Representative at the below-listed telephone number if there are any questions regarding this Response or if prosecution of the application may be assisted thereby.

A request for an extension of time to respond to the Restriction Requirement is enclosed herewith.

Respectfully submitted,

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By their Representatives,

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Date *Nov. 21, 2002*

By *Ann M. McCrackin*
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 21st day of November, 2002.

Name Ann McCrackin

Ann M. McCrackin
Signature